

REMARKS/ARGUMENTS

Claims 1 - 25 have been previously canceled. Claims 26 - 51 are canceled herewith and new claims 52 - 77 are presented for reconsideration and further examination in view of the foregoing amendments and following remarks.

In the outstanding Office Action, claim 49 was objected to because of informalities; claim 50 was objected to under 37 CFR 1.75(c) as being of improper dependent form; claims 26, 27, and 31 - 46 are rejected on the ground of non-statutory obviousness-type double patenting; claims 26 - 35, 27 - 40, 50, and 51 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,891,015 to Strahle; claim 36 was rejected under 35 U.S.C. §103(a) as being unpatentable over Strahle; claim 41 was rejected under 35 U.S.C. §103(a) as being unpatentable over Strahle in view of U.S. Patent No. 5,841,578 to Hoogland; claims 42 - 46 were rejected under 35 U.S.C. §103(a) as being unpatentable over Strahle in view of U.S. Patent No. 5,423,312 to Siegmund et al.; and claims 47 - 49 were rejected under 35 U.S.C. §103(a) as being unpatentable over Strahle in view of U.S. Patent No. 6,730,019 to Irion.

By this Response and Amendment, claims 26 - 51 are canceled; new claims 52 - 77 are presented; and the rejections have been traversed.

Support for the new claims can be found for example in canceled claims 26 - 51, generally and in Figures 1A - 1C. New claim 52 corresponds to canceled claim 26, but it now specifies that the image plane is located at the distal end of the slender tube and additionally indicates features regarding the telescopic system. The telescopic system has at least one lens disposed between the imaging system and the proximal end of the slender tube, and the space substantially filled by the

transparent optical is between the imaging system and this lens and/or between this lens and the proximal end of the slender tube.

Most of new claims 53 - 71 depend from claim 52 and correspond to canceled claims 27 - 51, though some dependent claims such as claims 73 - 76 define new features. Support for claims 73 - 76 can be found for example in Figures 1A - 1C. In new claim 69, a typographical error has been corrected in canceled claim 49. New claim 72 is directed to overcome the Examiner's formal objection to claim 50 and it defines a slender tube in an independent form, as suggested by the Examiner. New claims 73 to 77 depend on claim 72 and correspond to new Claims 53 - 56, and 70, and depend on new claim 52.

As such, it is respectfully submitted that the above amendments do not introduce any new matter, within the meaning of 35 U.S.C. §132, to this application.

Claim Objections

Claim 49 was objected to because of informalities. Specifically, line 2 contains a typographical error regarding a period after the word particular. Claim 50 was objected to under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Response

In response, claim 49 has been canceled and is now claim 69, where the period "." has been deleted. Further, claim 50 has been canceled and is now claim 72 which is directed to overcome the Examiner's formal objection to claim 50, and it defines a slender tube in an independent form, as

suggested by the Examiner. As the new claims are absent the informalities and the improper dependency of the previous claims, Applicants request that the objections be withdrawn.

Double Patenting

Claims 26, 27, and 31 - 46 are rejected on the ground of non-statutory obviousness-type double patenting. In particular, these claims were found to be unpatentable over claims 1 - 18 of U.S. Patent No. 7,018,330 to Alekseenko et al. The Examiner stated that claim 26 [*sic*] of the present application recites an imaging system which forms an image plane located "distally to the optical media," whereas [claim 1 of] U.S. Patent No. 7,018,330 recites an image plane located on an axis "within said tube at the distal end thereof." Furthermore, claims 31 - 35 and 37 - 46 of the present application were found to be identical to claims 3 - 7 and 9 - 18 of U.S. Patent No. 7,018,330, respectively.

Response

A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). See MPEP 804 II.B.1.

In the Office Action, the Examiner has failed to provide an analysis that parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. In other words, the differences

between the conflicting claims have not been discussed and no motivation for modifying the copending application has been given.

However, in order to expedite prosecution of this application, Applicants submit a Terminal Disclaimer herewith.

Rejections Under 35 U.S.C. §102(b)

Claims 26 - 35, 27 - 40, 50, and 51 were rejected as being anticipated by Strahle.

Response

By this Response and Amendment, Applicant respectfully traverses the Examiner's rejection since each and every element of the presently claimed invention are not disclosed, taught, or suggested by the cited prior art.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Independent claim 26 has been canceled and replaced by new claim 52, which recites a combination of features, *inter alia*, "said imaging system and said image plane being disposed at said distal end of the slender tube,..." (*emphasis added*). Independent claim 72 recites a combination of features, *inter alia*, "said slender tube having a distal and a proximal end mountable within said

housing so that a part of said telescopic system is disposed within said housing..." and "said imaging system located, together with said image plane, at the said distal end" (*emphasis added*).

In particular, the Examiner considered cancelled Claim 1 to be anticipated by Strahle and, specifically, to disclose an optical device with a slender tube as defined in Claim 1, having "an intermediate image plane [which] can be located closer to the distal end" of the slender tube. New Claim 52 specifies that the image plane is located at the distal end of the slender tube, and at least for this reason it is deemed to be novel over Strahle. The same argument led to the acceptance of the parent application.

The above is also correct with respect to new independent Claim 72 defining a slender tube, which is a part of the optical device defined in independent Claim 52. This new claim comprises the following additional limitations:

- the optical device comprises a housing within which the proximal end of the slender tube is mountable; and
- this end is mountable so that a part of the telescopic system is disposed within said housing.

The above limitations are not present in Strahle, since the reference does not disclose a housing within which proximal end of a slender tube is received, and within which a part of the telescopic system is disposed. In view of the above, independent Claim 72 is deemed to be fully patentable over Strahle.

The patentability of all dependent claims is deemed to be supported by the patentability of independent Claims 52 and 72. However, at least dependent Claims 53, 55, 56, 70, 71 and 73 - 77 are deemed to be independently patentable as defining features not disclosed in Strahle.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejection under 35 U.S.C. § 102(b).

Rejections Under 35 U.S.C. §103(a)

The Examiner rejected claim 36 as being unpatentable over Strahle; claim 41 was rejected as being unpatentable over Strahle in view of Hoogland; claims 42 - 46 were rejected as being unpatentable over Strahle in view of Siegmund et al.; and claims 47 - 49 were rejected as being unpatentable over Strahle in view of Irion.

Response

By this Response and Amendment, Applicants respectfully traverse the Examiner's rejection since all of the claim limitations of the presently claimed invention are not disclosed, taught, or suggested by the cited prior art.

To establish a prima facie case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Strahle has been discussed above, however, the Examiner cites Hoogland, Siegmund et al. and Irion in an attempt to cure the deficiencies of Strahle regarding the dependent claims.

None of Hoogland, Siegmund et al, and Irion cure the deficiencies of the Strahle '015 patent since none of the secondary references teach or suggest the features of independent claims 52 and 72 regarding "said imaging system and said image plane being disposed at said distal end of the slender

tube,...” (*emphasis added*) and “said slender tube having a distal and a proximal end mountable within said housing so that a part of said telescopic system is disposed within said housing...” and “said imaging system located, together with said image plane, at the said distal end” (*emphasis added*).

Moreover, the rejection is now deemed moot in view of the cancellation of these claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections under 35 U.S.C. § 103(a).

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

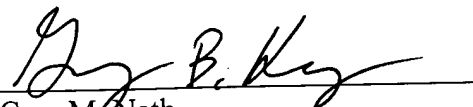
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